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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,843	12/19/2001	Mark Grayson	50255-092	4397

20277 7590 09/21/2004

MCDERMOTT WILL & EMERY LLP
600 13TH STREET, N.W.
WASHINGTON, DC 20005-3096

EXAMINER

CUMMING, WILLIAM D

ART UNIT	PAPER NUMBER
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2683

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/914,843

Applicant(s)

GRAYSON & LE GOFF

Examiner

WILLIAM D CUMMING

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 9 and 10 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 December 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1, 6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show the name of the boxes and/or items of figures 1, 3, 4, 9, 12, and 13 as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

3. INFORMATION ON HOW TO EFFECT DRAWING CHANGES

a. Replacement Drawing Sheets

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment. Any replacement drawing sheet must be identified in the top margin as "*Replacement Sheet*" (37 CFR 1.121(d)) and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. The figure or figure number of the amended drawing(s) must not be labeled as "*amended*." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin.

b. Annotated Drawing Sheets

A marked-up copy of any amended drawing figure, including annotations indicating the changes made, is required by the examiner. The annotated drawing sheets must be clearly labeled as "*Annotated Marked-up Drawings*" and accompany the replacement sheets.

c. Timing of Corrections

Applicants are required to submit acceptable corrected drawings within the time period set in the Office action. See 37 CFR 1.85(a). Failure to take corrective action within the set period will result in ABANDONMENT of the application.

Specification

4. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

5. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicants' cooperation is requested in correcting any errors of which applicant may become aware in the specification.

6. The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.

- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
 - (1) Field of the Invention.
 - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

7. The disclosure is objected to because of the following informalities:

The specification does not have section titles.

Appropriate correction is required.

Claim Objections

8. Claims 9 and 10 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend on any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claims 9 and 10 will not be further treated on the merits.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 3, 4, 6, 7, and 8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The terms "*equation (6a)*" or "*(7a)*", etc. is indefinite since it fails to particularly point out and distinctly claim the invention.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

12. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

13. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by **Maine**.

Maine discloses a method of determining the position of a mobile station

(figure 1, #38) in a satellite mobile telephone system (#10). The method comprising the steps of receiving propagation information from at least one satellite (#14) at a mobile station (#38, 30, 40, 30) and processing the propagation at the mobile station (#38, 30, 40, 30). Also note column 11, lines 10-22 and column 21, line

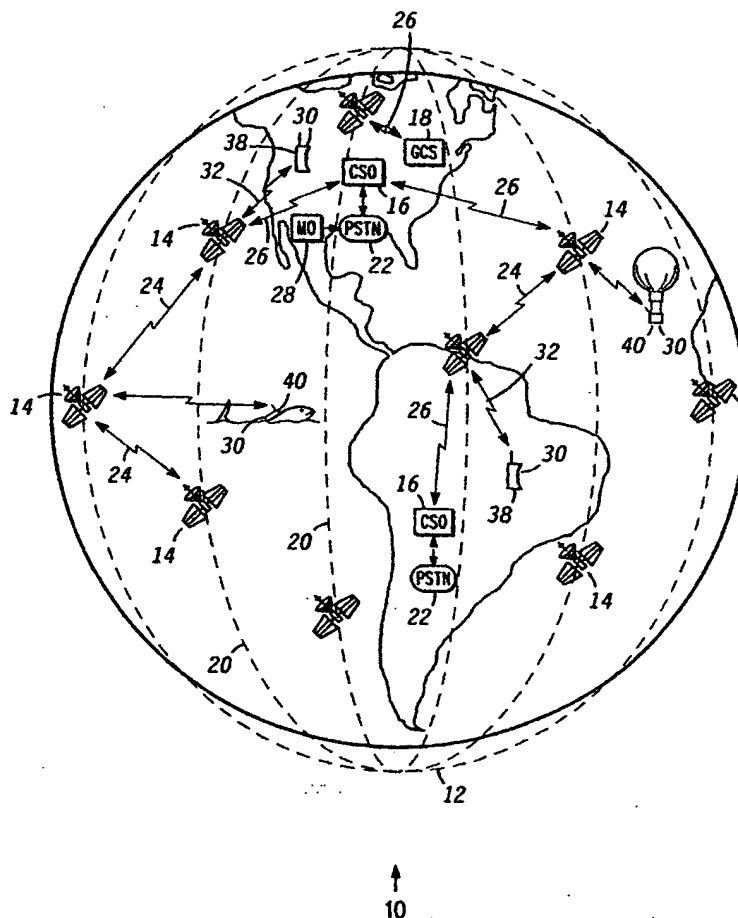


FIG. 1

12 to column 22, line 22 and figure 11.

14. Claims 1, 2, and 5 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by **Levanon**.

Levanon discloses a method of determining the position of a mobile station (figure 1, #106B, C) in a satellite mobile telephone system (#100). The method comprising the steps of receiving propagation information from at least one satellite (#104) at a mobile station (#106B,C) and processing the propagation at the mobile station (#106b,C). Also note claims 1, 3, 18 and figure 7.

NON-FINAL REJECTION

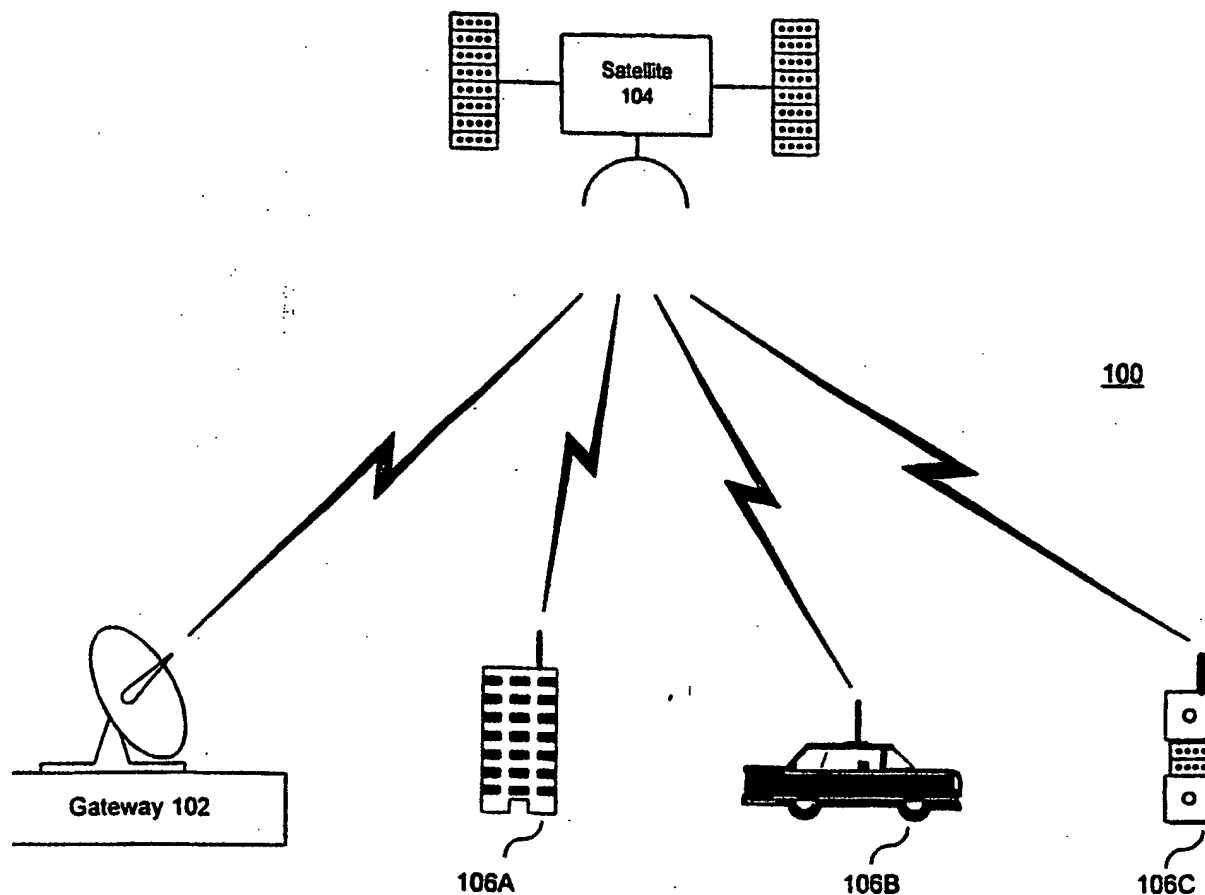


FIG. 1

Regarding claims 2 and 5, Levanon clearly states, "Control processor 220 uses such information to determine to what extent the received signals are offset from an expected frequency, based on a local oscillator frequency, when scaled to the same frequency band, as appropriate. This and other information related to frequency offsets, errors and Doppler shifts, can be stored in one or more error/Doppler storage or memory elements 236, as desired. This information can be used by control processor 220 to adjust its operating frequency, or can be

NON-FINAL REJECTION

transferred to gateways using various communication signals." And, "Additional, storage or memory elements 240 and 242 can be used to store specific information about parameters discussed in further detail below. For example, a memory element 240 can store user terminal measurements made relative to a range-rate parameter, such as differences in relative frequency offsets between two arriving signals. A memory element 242 could be used to store user terminal measurements relative to a range difference parameter, such as differences in the time of arrival for two signals. These memory elements use structure and circuits well known in the art and can be formed either as distinct or separate elements or as a larger unified structure in which this information is stored in a controlled manner, for later retrieval."

Conclusion

15. All Electronic Copies of Patent Application Records Will Now Be Provided as Certified Copies in Electronic Form

The United States Patent and Trademark Office (USPTO) is changing to an electronic format for the electronic certified copies it supplies of 1) U.S. patent applications as filed, and 2) U.S. patent-related file wrappers and contents. Copies of U.S. patent application documents made from the USPTO's Image File Wrapper (IFW) electronic system will be provided entirely in electronic form and will always be provided as certified copies. In addition, certified copies of patent application documents will no longer be bound, regardless of whether produced from IFW or a paper file.

For the last two years certified copies of large patent application files produced from the USPTO's electronic systems have been provided only on compact disc, with an attached paper certification statement. Currently, certified copies of patent applications as filed of 400 or more pages and all certified File Wrapper copies produced from IFW are provided on compact disc (CD), both with attached paper certification statements. The \$200 fee for a file wrapper and contents was effectively waived and replaced by a \$55 fee when the application contents are provided on CD. See Copies of File Contents Available on Compact

Disc Partial Waiver of 37 CFR 1.19(b), 1278 Off. Gaz. Patent Office 261 (Jan. 27, 2004). The fee for an application as filed remains \$20, as set forth in 37 CFR 1.19(b)(1), even when the copy is provided on compact disc.

Effective July 30, 2004, all copies of patent documents purchased under 37 CFR 1.19 and produced from IFW will be provided only as electronic files, with an imaged certification statement included as part of a digitally signed PDF (portable document format) file containing TIFF (tag image file format) images of the document pages. These electronic files may be downloaded from the USPTO website or provided by the USPTO on compact disc. The electronic files are digitally signed by the USPTO for authenticity and integrity, and cannot be undetectably modified. As mentioned above, all copies purchased pursuant to 37 CFR 1.19 and produced from IFW will be produced only as certified copies. Uncertified copies may be downloaded under the USPTO's Public PAIR system.

Before submitting electronic certified copies of the application as filed supplied on CD or in another electronic form to intellectual property offices under Article 4 of the Paris Convention for the Protection of Industrial Property applicants should inquire whether that office accepts priority documents in electronic form. Although the USPTO provides a certified copy in electronic form, applicants may print the certified copies to paper if required by the intellectual property office to which it is submitted.

The USPTO is actively engaging in discussions with other intellectual property offices for the mutual acceptance of electronic priority documents. Should another intellectual property office not accept a paper or electronic certified copy of a patent application as filed as described in the above paragraph, upon presentation of a notice of non-acceptance by the other office, the USPTO will provide a substitute paper copy with a letter signed by an official of the USPTO addressed to the foreign office indicating that the certified copy of the application as filed is to be accepted under Article 4 of the Paris Convention for the Protection of Industrial Property. Since the USPTO will no longer bind or rivet paper certified copies of patent applications as filed or file wrappers and contents, copies produced by the Office will be identical to copies printed by an applicant from the electronic certified

16. If applicants wish to request for an interview, an *"Applicant Initiated Interview Request"* form (PTOL-413A) should be submitted to the examiner prior to the interview in order to permit the examiner to prepare in advance for the interview and to focus on the issues to be discussed. This form should identify the participants of the interview, the proposed date of the interview, whether the interview will be personal, telephonic, or video conference, and should include a brief description of the issues to be discussed. A copy of the completed *"Applicant Initiated Interview Request"* form should be attached to the Interview Summary form, PTOL-413 at the completion of the interview and a copy should be given to applicant or applicant's representative.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **WILLIAM D CUMMING** whose telephone number is 703-305-4394. The examiner can normally be reached on Monday-Thursday 10:30am to 8:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **WILLIAM TROST** can be reached on 703-308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

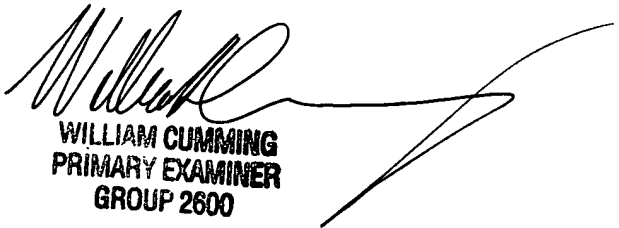
18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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